

Notice of Allowability

Application No.

09/754,755

Examiner

S. B. McCormick-Ewoldt

Applicant(s)

ELSNER, WILHELM

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to June 9, 2006.
2. ☒ The allowed claim(s) is/are 1.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

The communication of June 9, 2006 is hereby acknowledged.

35 U.S.C. § 102

The rejection of claim 1 under 35 U.S.C. 102(b) has been withdrawn in view of Applicant's response dated June 9, 2006.

Applicant admits that the commercial sales of the variety did not occur more than one year before the filing date of the present application. The standard set under *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states "the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. Its availability must have been known in the art, just as a printed publication must be publicly available" (1043). Applicant admits that the earlier averment that commercial sales of 'Tikvio' took place in 1998 (response dated April 12, 2002) was made in error. Those distributions were not public and were for testing and trial purposes only.

Since the distributions were not public, this would indicate that Applicant did not sell the plant to wholesalers, retailers or others more than one year prior to the filing date in the U.S. Applicant admits that the earlier averment was made in error and therefore does not enable the publication. As such, it does not constitute prior art under 35 U.S.C. 102(b).

Reasons for Allowance

The following is an Examiner's statement of reasons for allowance:

The information regarding the cultivar Tikvio was described in the European Community Plant Breeder's Right application number, 19981017, and published on October 15, 1998. The printed publication was accessible to the public more than one year prior to the filing date of this instant application. A publication relied upon as prior art under 35 USC 102(b) must be enabling. The text of the relied upon publications standing alone would not enable one skilled in the art to practice the claimed invention.

When the claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to obtain or reproduce the plant. See *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain and

Art Unit: 1661

reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure.

In the response dated June 9, 2006, Applicant states the claimed plant has not been sold or available to the American public anywhere in the world prior to the filing in the United States. However, the standard is not the "American" public. Enablement of a publication is not required to occur for the "American" public. Sale anywhere in the world coupled with a publication of the plant wherein the sale and publication occurred more than a year prior to filing, constitutes a statutory bar under 102(b) if one of ordinary skill in the art could have obtained and propagated the plant more a year prior to filing and wherein the sale was not isolated or solitary. The printed publication cannot be enabling more than one year prior to filing because the disclosed cultivar was not propagated or obtained from publicly available materials.

The specification provides as complete a botanical description as is reasonably possible of the claimed plant. The completeness of the description is sufficient to distinguish this new plant from the prior art.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Correspondence

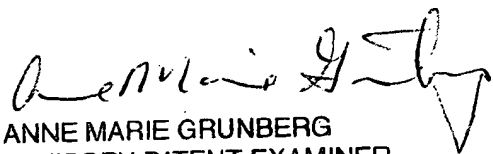
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The official fax number for the group is (571) 273-8300.

Art Unit: 1661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER